

REMARKS

Claims 1, 4, 6-9, 12-16, 18, 21-23, 25, and 28-40 were pending in the present application. Claims 2-3, 5, 10-11, 17, 19-20, 24, 26-27, and 41-64 are hereby canceled without prejudice or disclaimer. Claims 65-78 are new. Thus, claims 1, 4, 6-9, 12-16, 18, 21-23, 25, 28-40, and 65-78 are pending. Claims 1, 21, and 31 are hereby amended. Support for the amendments can be found in the specification at pg. 11, lines 12-21 through page 12, lines 1-9, and pg. 19, lines 19-22 through pg. 20, lines 1-4. The claims have not been amended for reasons related to patentability, but are amended to expedite the allowance of this case. Claims 1, 4, 6-9, 12-16, 18, 21-23, 25, and 29-40 are rejected under 35 U.S.C. § 102(e). Claim 28 apparently has not been examined in the present Action. Applicant respectfully requests reconsideration of the pending claims in view of the following remarks and foregoing claim amendments.

Reply to Notice of Non-Responsive Amendment

Applicant herein addresses the Notice of Non-Responsive Amendment (hereinafter the Notice) dated December 5, 2005. The Notice stated that the Amendment filed on July 22, 2005 (not on September 6, 2005) (hereinafter the Amendment) was not fully responsive to Office Action of April 22, 2005. Particularly, the Notice stated:

The requirements of 37 CFR 1.111(b) must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

(Emphasis in original) Applicant respectfully believes that the Amendment as originally filed was fully responsive with respect to claim amendments and new claims. Applicant resubmits the Amendment, along with these remarks in reply to the Notice of Non-Responsive Amendment.

With regard to amended claims 1, 21, and 31, Applicant includes arguments identifying elements of the amended claims which are not taught or suggested by the references cited. For example, the argument for claim 1 below includes the statement that the '858 patent does not anticipate the element(s), "... wherein the action includes implementing personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location," among other elements. The argument for claim 21 below states, "[T]he '858 patent does not teach or suggest the limitation of ... wherein the action includes implementing

personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location." With regard to claim 31, the Amendment argues, "[T]he '858 patent does not teach or suggest the limitation of ... wherein the action is based on rules which include implementing personalized features associated with the wireless device at a delineated location based at least in part upon previous user habits while using the wireless device at the delineated location." Each of these arguments goes directly to the amendments made to these claims. Moreover, similar arguments are made with respect to the '894 patent and the '475 patent, where appropriate.

With regard to newly added claims 65-78, each depending from claims 21 or 31, the Amendment below references the previous arguments cited, "Based on the foregoing remarks, Applicant believes that new claims 65-78 are also in condition for allowance." Since their base claims are believed allowable over the references cited, the new claims are also allowable for at least the same reasons.

Claim Rejections Under 35 U.S.C. § 102(e)

A. Independent Claims 1, 21, and 31 Are Not Anticipated by U.S. Patent No. 6,876,858

Claims 1, 4, 6-9, 12-16, 21-23, 29-32, 34, 37-38, and 40 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,876,858 to Duvall et al. (hereinafter "the '858 patent"). Applicant asserts that the '858 patent does not anticipate amended independent claims 1, 21, and 31.

Amended independent claim 1 recites: A system for use with a wireless device characterized by a location for executing an action specified in subscriber rules based on location information comprising: a location system in communication with the wireless device configured to generate location information associated with the wireless device; and a feature server in communication with the location system and the wireless device, the feature server configured to perform the action according to the subscriber rules if the location information satisfies the subscriber rules, wherein the action includes implementing personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location.

The Office Action states that the '858 patent "clearly anticipates" claims 1, 4, 6-9, 12-16, 21-23, 29-32, 34, 37-38, and 40. Applicant respectfully disagrees. To anticipate, a reference must teach each and every element of a claim. The '858 patent does not teach or suggest each and every element of amended independent claim 1.

The '858 patent describes using the cellular phone network control channel for portable cellular phone voice communication and positional location data communication. A user can voice-call a control center from a portable cellular telephone location over the cellular voice path and request location information services. After user verification, the control center sends a radio signal over a control channel path to be received at the location. The user's vehicle includes a separate vehicle module which includes a radio transponder, GPS receiver and microprocessor. The GPS receiver is activated to receive and process location data from the GPS satellite constellation in response to receipt of the radio signal transmitted from the control center. The transponder then transmits the processed location data over the control channel path to the control center. The transmitted location data is associated with the user voice call request at the control center, and location information is sent from the control center to the user.

The '858 patent does not teach each and every element of amended claim 1. For example, the '858 patent does not teach or suggest a feature server in communication with a location system and a wireless device, the feature server configured to perform an action according to subscriber rules if the location information satisfies the subscriber rules, wherein the action includes implementing personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location. Since the '858 patent does not teach each and every element of amended claim 1, the '858 patent does not anticipate amended claim 1. For at least these reasons, amended claim 1 is patentable over the '858 patent. Applicant respectfully requests withdrawal of the rejection to amended claim 1 and allowance thereof.

Claims 4, 6-9, 12-16, 18 depend from amended claim 1 and contain additional important limitations. For at least the reasons stated above, claims 4, 6-9, 12-16, 18 are not anticipated by the '858 patent. Thus, Applicant respectfully requests withdrawal of the rejection of claims 4, 6-9, 12-16, 18 and allowance thereof.

Amended independent claim 21 recites: A method for executing an action based on location information comprising: (a) receiving subscriber rules associated with a wireless device,

wherein the wireless device is characterized by a location; (b) receiving the location information associated with the wireless device; (c) reviewing the location information and the subscriber rules; and (d) executing the action if the location information satisfies the subscriber rules, wherein the action includes implementing personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location.

Amended independent claim 31 recites: A method for using a wireless device comprising: (a) delineating a location; (b) defining an action to be executed when the wireless device is at the delineated location, defining an action to be executed when the wireless device is at the delineated location, wherein the action is based on rules which includes implementing personalized features associated with the wireless device at a delineated location based at least in part upon previous user habits while using the wireless device at the delineated location; (c) comparing the wireless device's location to the delineated location; and (d) executing the action if the location information indicates that the wireless device is at the delineated location.

The Office Action states that “Regarding claims 21-23, 29-32, 34, 37, 38, 40, the claimed method is an inherent method to operate the system of Duvall, et al as stated above.” However, upon closer examination, claims 21-23, 29-32, 34, 37, 38, 40 include important limitations and are entitled to proper examination based on the limitations recited therein and should not be summarily dismissed without proper examination and supporting evidence. Moreover, the conclusory statements asserted in rejecting the claims are not only insufficient under Federal Circuit precedent (See In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)), but also fail to address the specific limitations required by claims 21 and 31 and their dependents.

Additionally, MPEP 2144.03 states:

“Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).”

Importantly, MPEP 2144.03 adds:

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697 ('[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.'). See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board's decision, the court stated " 'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.')."

Apparently, the Examiner is impermissibly and in conclusory fashion, suggesting that the '858 patent anticipates claims 21-23, 29-32, 34, 37, 38, 40 by relying solely on the Examiner's knowledge and generalized statements without regard to what is actually claimed. This is impermissible. The record needs to include an evidentiary basis for factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002). Applicant also submits that the Examiner has not satisfied MPEP §702.02(j). MPEP §702.02(j) requires that the prior art references teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination must be found in the prior art and not based on Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicant asserts that the '858 patent does not teach each and every element of amended claim 21. The '858 patent is described above. For example, the '858 patent does not teach or suggest the limitation of executing the action if the location information satisfies the subscriber rules, wherein the action includes implementing personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location. Since the '858 patent does not teach each and every element of amended claim 21, the '858 patent does not anticipate amended claim 21. For at least these reasons, amended claim 21 is patentable over the '858 patent. Applicant respectfully requests withdrawal of the rejection to amended claim 21 and allowance thereof.

Claims 22-23, and 28-30 depend from amended claim 21 and contain additional important limitations. For at least the reasons stated above, claims 22-23, and 29-30 are not anticipated by the '858 patent. Thus, Applicant respectfully requests withdrawal of the rejection of claims 22-23, and 29-30 and allowance thereof.

The '858 patent is described above. Applicant asserts that the '858 patent does not teach each and every element of amended claim 31. For example, the '858 patent does not teach or suggest the limitation of defining an action to be executed when the wireless device is at the delineated location, wherein the action is based on rules which include implementing personalized features associated with the wireless device at a delineated location based at least in part upon previous user habits while using the wireless device at the delineated location. Since the '858 patent does not teach each and every element of amended claim 31, the '858 patent does not anticipate amended claim 31. For at least these reasons, amended claim 31 is patentable over the '858 patent. Applicant respectfully requests withdrawal of the rejection to amended claim 31 and allowance thereof.

Claims 32, 34, 37-38, and 40 depend from amended claim 31 and contain additional important limitations. For at least the reasons stated above, claims 32, 34, 37-38, and 40 are not anticipated by the '858 patent. Thus, Applicant respectfully requests withdrawal of the rejection of claims 32, 34, 37-38, and 40 and allowance thereof.

B. Independent Claims 1, 21, and 31 Are Not Anticipated by U.S. Patent No. 6,677,894

Claims 1, 8, 21, 25, 31, 33, and 39 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,677,894 to Sheynblat et al. (hereinafter "the '894 patent"). Applicant asserts that the '894 patent does not anticipate amended independent claims 1, 21, and 31. Again, to anticipate, a reference must teach each and every element of a claim. The '894 patent does not teach or suggest each and every element of amended independent claims 1, 21, and 31.

The '894 patent describes a method and apparatus for providing information, such as location-based services, specific to a client's location or a location of interest, via the Internet and in particular, the World-Wide Web. The client provides information about its location and/or a location of interest to a Web server. The Web server provides information relating to the client's

location or location of interest to the client via the Internet. The '894 patent does not teach each and every limitation recited in amended independent claims 1, 21, and 31.

For example, with respect to amended claim 1, the '894 patent does not teach or suggest a feature server in communication with a location system and a wireless device, the feature server configured to perform an action according to subscriber rules if the location information satisfies the subscriber rules, wherein the action includes implementing personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location.

As another example, with respect to amended claim 21, the '894 patent does not teach or suggest the limitation of executing the action if the location information satisfies the subscriber rules, wherein the action includes implementing personalized features associated with the wireless device at a particular location dependent upon user preference at the particular location.

Finally, as further example, with respect to amended claim 31, the '894 patent does not teach or suggest the limitation of defining an action to be executed when the wireless device is at the delineated location, wherein the action is based on rules which include implementing personalized features associated with the wireless device at a delineated location based at least in part upon previous user habits while using the wireless device at the delineated location.

For at least these reasons, amended claims 1, 21, and 31 are patentable over the '894 patent. Applicant respectfully requests withdrawal of the rejection to amended claims 1, 21, and 31 and allowance thereof.

Claim 8 depends from amended claim 1 and includes additional important limitations. Claim 25 depends from amended claim 21 and includes additional important limitations. Additionally, claims 33 and 39 depend from amended claim 31 and include additional important limitations. For at least the reasons stated above, claims 8, 25, 33 and 39 are not anticipated by the '894 patent. Thus, Applicant respectfully requests withdrawal of the rejection of claims 8, 25, 33 and 39 and allowance thereof.

C. Independent Claim 31 Is Not Anticipated by U.S. Patent No. 6,829,475

Claims 31, 35 and 36 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,829,475 to Lee et al. (hereinafter "the '475 patent"). Applicant asserts that the '475 patent does not anticipate amended independent claim 31. Reiterating, to anticipate, a reference

must teach each and every element of a claim. The '475 patent does not teach or suggest each and every element of amended independent claim 31. Amended claim 31 is listed above.

The '475 patent describes an internet radio for portable applications and uses such as in an automobile. One object is to allow any AM, FM, TV audio, or digital audio broadcast or any Internet audio broadcast to be easily selected by format (i.e., country, classical, news, rock, talk, etc.) in a vehicle. The user will not need to know the band or frequency of any station to select a broadcast as all types of broadcasts are simply ordered by format. The appropriate band and frequency selections are made when a listener selects a station hierarchically organized under a format category. The '475 patent describes that customized information is communicated to the radio such as stock quotes, travel information, advertising, and e-mail. Onboard global positioning allows for channel updating by location, traffic information, geographic advertising and available similar content.

Applicant asserts that the '475 patent does not teach each and every element of amended claim 31. For example, the '475 patent does not teach or suggest the limitation of defining an action to be executed when the wireless device is at the delineated location, wherein the action is based on rules which include implementing personalized features associated with the wireless device at a delineated location based at least in part upon previous user habits while using the wireless device at the delineated location. Since the '475 patent does not teach each and every element of amended claim 31, the '475 patent does not anticipate amended claim 31. For at least these reasons, amended claim 31 is patentable over the '475 patent. Thus, Applicant respectfully requests withdrawal of the rejection to amended claim 31 and allowance thereof.

Claims 35-36 depend from amended claim 31 and contain additional important limitations. For at least the reasons stated above, claims 35-36 are not anticipated by the '475 patent. Thus, Applicant respectfully requests withdrawal of the rejection of claims 35-36 and allowance thereof.

D. New Claims 65-78 Are Allowable

Based on the foregoing remarks, Applicant believes that new claims 65-78 are also in condition for allowance.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that this response addresses each and every point of the Office Action and believes that the present application is in condition for allowance. Reconsideration of the application and allowance of the claims is respectfully requested. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact the undersigned attorney at the number below.

Respectfully submitted,
MERCHANT & GOULD, LLC

Date: January 5, 2006

By: Colin S. Wright
Colin S. Wright
Reg. No. 57,202

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-9946
Telephone: 404.954.5100

